

Remarks Amendment B**Specification**

The office action states that the sentence "Scalloped gripping teeth **44** facilitate deeper penetration in conduits **18** and **20** with less clamping force", added by Amendment A, must be removed because it is new matter.

This amendment removes the objected to sentence.

Claims

Claim 1:

Claim 1 is amended to replace the word "wherein" with "whereby".

The OA rejects Claim 1 as rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's prior art Figure 1 in view of US patent 1369913, Brunhoff.

As noted in Amendment A, the pipes described in the cited Brunhoff patent, 1369913, must be free to rotate with respect to one another when the toggle clamps are in the clamped position. Quoting, as noted in Amendment A, from the Brunhoff patent, page 1, lines 101-108:

"A receiver is then adjusted to catch any oil flowing from the spout 16, and the **pipe section** above the pipe sleeve engaged by the oil saver is **then turned, slipping rotatably** in the upper packing ring 30, until the **pipe joint is broken** (axially) and the oil escapes into the sleeve and flows from the spout 16 to the receiver."

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Brunhoff "teaches away" from Figure 1. To reiterate the Applicant's arguments of Amendment A, Brunhoff's sump would be made useless if the gripping means of Figure 1 were applied to Brunhoff since the necessary rotation ("turned, slipping rotatably") and axial movement would be prevented. This would render the Brunhoff sump inoperable. In M.P.E.P. 2143.01:

"If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification."

Respectfully, the **joining of conduits** is the subject of the art of this application. Brunhoff is therefore nonanalogous. **Brunhoff has nothing to do with joining conduits or pipes.** Brunhoff does not suggest or imply that the use of a pair of toggle clamps can be used to rigidly join two conduits.

Figure 1 is mute about anything relating to toggle clamps. Nothing in the Figure 1 prior art suggests or implies that any other technique than that shown is desirable for rigidly joining conduits.

The Application states that the field of the art is the joining of conduits, typically underground, in which fiber optic cable is installed. An individual having ordinary skill in the art would therefore have to be skilled in the art associated with laying conduit in trenches and the subsequent installation of fiber optic cable. That individual would have to be familiar with the rigid coupling of conduits and the prevention of axial and rotational movement of the conduits required by the noted industry. For example, in ASTM F2176-02, Standard Specification for Mechanical Couplings Used on Polyethylene Conduit, Duct and Innerduct:

Remarks Amendment B (con'd)**"Table 1 Mechanical Joint Pullout Resistance**

Nominal Conduit Size	Minimum Pullout Resistance
3/4 IPS	380 lbs (172kg)
1 IPS	760 lbs (345 kg)
1 1/4 IPS	940 lbs (426 kg), ...Etc."

The best of modern computerized techniques of analysis would not assure a skilled individual that toggle clamps could somehow be substituted for the bolts described in Figure 1. The Applicant, skilled in the art, had to resort to building an experimental mold to produce experimental parts and then test the invention to determine whether the invention had utility in the field of this art. As with the Applicant, any skilled artisan would have to use analysis, and then **experimentation** to know for sure that toggle clamps could provide the desired result. The Applicant was rewarded with the unexpected result that the gripping teeth and the toggle clamp combination provided a useful clamp. The expectation of **success could not be anticipated by reason alone**. This was **not** and is **not obvious** to someone skilled in the art in the field of this invention.

Since a long felt but unsolved need is filled by this invention the Applicant feels it is necessary to restate a paragraph from Amendment A of this Application:

"Soft plastic conduits have been installed in trenches for decades. Many schemes for joining these conduits have been implemented by those skilled in the art. It is, and has been, highly desirable to produce a coupling that does not require tools to apply, is easy to apply, does not have loose parts that can be lost during installation, can be reused, is inexpensive to manufacture, provides positive resistance to the separation of the conduit, and provides an adequate seal. Over these

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decades of need, those skilled in the art have not pursued the coupling structure of this invention. It is remarkable that the coupling of this invention can cause the significant gripping penetration by the simple use of toggle clamps. This fact, along with the structural features of this invention, has been **overlooked by those skilled in the art**".

Further, with regard to the proposed combination of Brunhoff and prior art of Figure 1, it is well known that in order for any prior-art references themselves to be validly combined for use in a prior-art 103 rejection, the references themselves (or some prior art) must suggest that they be combined. This was stated in *In re Sernaker*, 702 F.2d 989 (1983):

"Prior art references in combination do not make an invention obvious unless something in the prior art references would suggest the advantage to be derived from combining their teachings".

The suggestion to combine the references should not come from the Applicant as forcefully stated in *In Orthopedic Equipment Co. v. United States*, 702 F.2d 1005 (1983):

"It is wrong to use the patent in suit (here the patent application) as a guide through the maze of prior art references, combining the right references in the right way to achieve the result of the claims in suit (here the claims pending). Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law (here the USPTO)".

Also, *In Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044 (Fed. Cir.1988) regarding hindsight:

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"Where prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. ...Something in the prior art must suggest the desirability and thus the obviousness of making the combination".

In line with these decisions the Board stated in *In Ex parte Levengood*, 28 U.S.P.Q.2d 1300:

"In order to establish a prima facie case of obviousness, it is necessary for the examiner to present evidence, preferably in the form of some teaching, suggestion, incentive or inference in the applied prior art, or in the form of generally available knowledge, that one having ordinary skill in the art would have led to combine the relevant teachings of the applied references in the proposed manner to arrive at the claimed invention. ...That which is within the capabilities of one skilled in the art is not synonymous with obviousness. ... That one can reconstruct and/or explain the theoretical mechanisms of an invention by means of logic and sound scientific reasoning does not afford the basis for an obviousness conclusion unless that logic and reasoning also supplies sufficient impetus to have led one of ordinary skill in the art to combine the teachings of the references to make the claimed invention. ...Our reviewing courts have often advised the Patent and Trademark Office that it can satisfy the burden of establishing the prima facie case of obviousness only by showing some objective teaching in either the prior art, or knowledge generally available to one of ordinary skill in the art, that "would lead" that individual "to combine the relevant teachings of the references." ...Accordingly, an examiner cannot

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patent applicant's invention without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done".

In the present case, there is no reason (evidence of motivating force) given in the last OA to support the proposed combination.

As stated above in the Levengood case,

"That one can reconstruct and /or explain the theoretical mechanism of an invention by means of logic and sound scientific reasoning does not afford the basis for an obviousness conclusion unless that logic and reasoning also supplies sufficient impetus to have led one of ordinary skill in the art to combine the teachings of the references to make the claimed invention".

Applicant therefore respectfully submits that combining prior-art Figure 1 and Brunhoff is not legally justified and is therefore improper. Thus the Applicant respectfully submits that the rejection on these references is also improper and should be withdrawn.

Also, the Applicant respectfully requests, if the claims are again rejected upon any combination of references, that the Examiner include an explanation, in accordance with M.P.E.P. 706.02, Ex parte Clapp, 27 U.S.P.Q. 972 (P.O.B.A. 1985), and Ex parte Levengood, supra, a "factual basis to support his conclusion that it would have been obvious" to make the combination.

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Claim 2,3,6 and 7:

The OA rejects these claims in view of Applicant's prior art Figure 1. It is felt that if the rejection of Claim 1 is withdrawn, that these claims will be allowed.

Claim 5:

The OA rejects this claim in view of combined prior art of Figure 1, Brunhoff and Ziedler. It is felt that if the rejection of Claim 1 is withdrawn, that this claim will be allowed.

Claim 4:

Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The allowance of this subject matter is appreciated, but will be respectfully held in abeyance pending disposition of this amendment.

Claim 8:

Method Claim 8 is added to further describe the invention.

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Conclusion:

For all the above reasons, Applicant submits that the specification and claims are in proper form, and that the claims all define patentability over the prior art.

Therefore, the Applicant submits that the application is now in condition for allowance and respectfully requests such action.

Very Respectfully,

A handwritten signature in cursive script, reading "Myrl J. Saarem".

Myrl J. Saarem

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